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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,506	01/10/2006	Matthias Ernst	052703	4654
38834 7590 02/15/2007 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER DOAN, TRANG T	
			ART UNIT 2131	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/15/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/539,506

**Applicant(s)**

ERNST ET AL.

**Examiner**

Trang Doan

**Art Unit**

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 2-15 and 17-23 are amended. Claims 1-23 are pending in this application.
2. The application is filed on 01/10/2006 but claims the benefit of Foreign Priority has been made and acknowledged. Therefore, the effective filing date for the subject matter defined in the pending claims in this application is 12/19/2002.

### ***Claim Objections***

3. Regarding claim 9, claim 9 recites the limitation "a individual" in lines 2. The examiner interprets as "an individual". Appropriate correction is required.
4. Regarding claim 15, claim 15 recites the limitation "personalisation" in line 2. The examiner interprets as "personalization". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1, 9 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 1 recites the limitation "the provider of the protected area" in line 10. There is insufficient antecedent basis for this limitation in the claim.

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8. Additionally to claim 1, the limitation "authentication and/or communication exclusively of the unique identifier of the second network to the provider of the protected area by means of the authentication unit" is not clearly defined. The examiner confuses with the language of this limitation. Appropriate correction is required.

9. Claims 9 recites the limitation "before release of a individual connection identification, a further entry on the terminal is necessary in addition" is not clearly defined. The examiner confuses with the language of this limitation. Appropriate correction is required.

10. Claim 16 recites the limitations "the different identifiers", "the other unique identifiers" and "the data" in lines 6 and 8-9. There is insufficient antecedent basis for this limitation in the claim.

11. Additionally to claim 16, the limitation "authentication and/or issue exclusively of one of the unique identifiers when a corresponding enquiry is made regarding the other unique identifiers" is not clearly defined. The examiner confuses with the language of this limitation. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by

Nakajima (US 2003/0169714) (hereinafter Nakajima).

14. Regarding claim 1, Nakajima teaches dynamic or static assignment of a unique identifier of the first network for a terminal, during or prior to the latter's connection to the first network by means of the second network (Nakajima: see figures 2-3 and paragraph [0036]: when connection is established, service terminal send an ID and an IP address to mobile terminal); storage of a combination of at least the unique connection identifier of the second network by means of which the connection was made, and the unique identifier of the first network in an authentication unit (Nakajima: see figure 2 item 210 and paragraphs [0037-0038]: subscriber database (210D) stores identification information (i.e., identification code and telephone number) for the mobile terminals); the provider of the protected area requesting the authentication unit to determine the unique connection identifier of the second network using the unique identifier of the first network when the terminal would like access to the protected area (Nakajima: paragraphs [0038-0039]); authentication and/or communication exclusively of the unique identifier of the second network to the provider of the protected area by means of the authentication unit (Nakajima: see paragraphs [0038-0039]); checking whether an access right for the protected area exists for the unique connection identifier of the second network (Nakajima: paragraphs [0039-0040 and 0045-0046]).

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15. Regarding claim 2, Nakajima teaches wherein the combination stored in the current authentication unit contains further data in addition (Nakajima: paragraph [0012]).
16. Regarding claim 3, Nakajima teaches characterized in that the additional data has at least one of the following: the dial-in number into the first network, a user name (login) and a password (Nakajima: see Abstract section and paragraph [0046]).
17. Regarding claim 4, Nakajima teaches wherein the authentication unit is only run temporarily (Nakajima: paragraphs [0042-0043]).
18. Regarding claim 5, Nakajima teaches wherein the combination of data is deleted from the authentication unit as soon as the terminal ends its connection with one of the two networks (Nakajima: paragraphs [0042-0043]).
19. Regarding claim 6, Nakajima teaches wherein the unique identifier of the second network is a call-up number (Nakajima: see Abstract section).
20. Regarding claim 7, Nakajima teaches wherein the protected area includes the provision of an online individual connection identification (Nakajima: paragraph [0055]).
21. Regarding claim 8, Nakajima teaches wherein a individual connection identification takes place automatically for the unique connection identifier of the second network (Nakajima: paragraph [0037]).
22. Regarding claim 9, Nakajima teaches wherein, before release of a individual connection identification, a further entry on the terminal is necessary in addition (Nakajima: see Abstract section and paragraph [0041]).

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23. Regarding claim 10, Nakajima teaches wherein the further entry includes the entry of an invoice number and/or a customer number and/or a PIN (Nakajima: see Abstract section and paragraph [0041]).
24. Regarding claim 11, Nakajima teaches wherein only authorised services have access to the authentication unit (Nakajima: paragraphs [0038-0039]).
25. Regarding claim 12, Nakajima teaches wherein the protected area includes at least one of the following services: provision of contents, electronic trade (e-commerce), payment or settlement services and authorized services (Nakajima: paragraph [0055]).
26. Regarding claim 13, Nakajima teaches wherein with a payment service, the costs arising are automatically invoiced by means of the unique connection identifier of the second network (Nakajima: paragraph [0041]).
27. Regarding claim 14, Nakajima teaches characterized in that further data are automatically called up from the terminal and/or further procedural steps are initiated in the protected area using the unique connection identifier of the second network (Nakajima: see Abstract section).
28. Regarding claim 15, Nakajima teaches wherein further personalization of the terminal takes place by entering a PIN (Nakajima: paragraph [0032]).
29. Regarding claim 16, this claim has limitations that is similar to those of claims 1 and 5, thus it is rejected with the same rationale applied against claims 1 and 5 above.
30. Regarding claim 17, Nakajima teaches wherein at least one of the identifiers is an IP number and/or a unique connection identifier of a terminal (Nakajima: see Abstract section).

31. Regarding claim 18, Nakajima teaches wherein it is checked whether the enquiry originates from an authorised place or from an authorised service (Nakajima: paragraph [0045]).

32. Regarding claim 19, Nakajima teaches wherein the combination stored in the current authentication unit contains further information in addition (Nakajima: paragraphs [0038 and 0040]).

33. Regarding claim 20, Nakajima teaches wherein the additional data have at least one of the following: a dial-in number into one of the networks, a user name (login) and a password (Nakajima: see Abstract section and paragraph [0046]).

34. Regarding claim 21, Nakajima teaches wherein a call-up number block or a target number block is identified by means of the authentication unit (Nakajima: paragraph [0039]).

35. Regarding claim 22, Nakajima teaches wherein the first and second networks are based on different protocols (Nakajima: paragraph [0028]).

36. Regarding claim 23, Nakajima teaches wherein the first network is the internet, and the second network is a telephone network (Nakajima: see figure 1).



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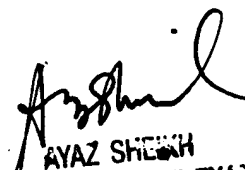
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trang Doan whose telephone number is (571) 272-0740. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Trang Doan  
Examiner  
Art Unit 2131

T.D.  
02/09/2007

  
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